

## Remarks

### Status of the Application

The Office objected to the drawings as missing Figure 11f.

The Office rejected Claims 4, 15, 30, and 38 under 35 U.S.C. 112.

The Office rejected Claims 2-3 and 10-23 under 35 U.S.C. 103 as obvious in view of US patents 6,421,548 (*Berman*) and 5,249,077 (*Laronga*).

The Office rejected Claims 27-38 under 35 U.S.C. 103 as obvious in view of US patents 6,421,548 (*Berman*), 5,249,077 (*Laronga*), and 5,859,434 (*Messerschmidt*).

The Office rejected Claims 4 and 39-40 under 35 U.S.C. 103 as obvious in view of US patents 5,616,922 (*Reffner*) and 5,945,674 (*Dukor*). In the interest of expeditious allowance, Applicant has canceled Claims 4 and 39-40.

### **Objections to the Drawings**

The Office indicated the Figure 11f was missing. Applicant submits herewith a new sheet showing Figure 11f as requested by the Office. Applicant submits that the corresponding rejection has been overcome.

### **Rejections under 35 U.S.C. 112**

While claiming in the alternative is allowable without requiring specific wording, Applicant has amended the subject claims to recite formal Markush group wording, responsive to the Office's request. Applicant submits that the corresponding rejections have been overcome.

### **Rejection of independent Claim 10, and Claims 2-3 and 11-23 depending therefrom, as obvious in view of *Berman* and *Laronga***

The Office repeated an earlier rejection of Claim 10, and Claims 2-3 and 11-23 depending therefrom, asserting that Applicant's previous response (1) did not comply with 37CFR 1.111(b) and (2) attacked the references individually. Applicant vigorously traverses the Office's characterization of the previous response. It is settled law that, in a rejection of claims as obvious, the Office has the burden of establishing a *prima facie* case. See MPEP 2142. To establish a *prima facie* case of obviousness, the art must, *inter alia*, teach or suggest every limitation of the claims. See MPEP 2142. Further, there must be some rationale for combining the references. See, e.g., MPEP 2143.01; *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Applicant's previous discussion identified a specific reason why the Office's proposed combination was impermissible, and identified specific limitations of the subject claims that were not taught or suggested in the references.

The combination of *Berman* and *Laronga* is impermissible. The present Office Action states "it was decided in the Courts that a change in size is an obvious matter ..." (no citation supplied). While this general proposition may be correct, a combination that destroys the utility of one of the references is impermissible. See, e.g., MPEP 2143.01; *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). *Berman*'s apparatus involves pressing a finger against a thick ATR interface to measure blood glucose. The Office's proposed combination requires that *Berman*'s thick ATR material be replaced with *Laronga*'s thin infrared-opaque material. Such replacement would produce a finger sampler in *Berman* that would break when in contact with a finger. Changing *Berman*'s apparatus so that users cut their fingers on broken sample interfaces surely destroys the utility of *Berman*'s apparatus. Accordingly, the proposed combination is impermissible, there is no *prima facie* case of obviousness, and the subject claims are in condition for allowance. See, e.g., MPEP 2143.01.

Even if combined, *Berman* and *Laronga* do not teach or suggest all the limitations of the subject claims. The Office invited Applicant to show features in the claims not disclosed by the art. Applicant has done so in previous communications. As an example, Applicant's Claim 10 recites limitations including a material functionally transparent to infrared light, disposed in a thickness of not more than 0.1 inches. While *Berman* mentions such materials, it has no suggestion of such a thickness (as discussed above, modifying *Berman* to meet Applicant's Claim 10 would destroy *Berman*'s utility). *Laronga* mentions thin materials, but has no suggestion of materials functionally transparent to infrared light. As another example, Applicant's specification taught a "sample" as a sample taken from a source, e.g., a tissue sample removed from a body. See, e.g., Specification paragraphs 3 and 16. Applicant has amended Claim 10 to explicitly recite the limitation that the first face is adapted to support an ex vivo sample. A materially functionally transparent to infrared light adapted to support an ex vivo sample is not taught or suggested in either *Berman* or *Laronga*. Accordingly, the references do not teach or suggest all the limitations of Claim 10. Combining them as suggested by the Office is impermissible since it destroys the utility of *Berman*. Consequently, there is no *prima facie* case of obviousness of Claim 10, and Claims 2-3 and 11-23.

**Rejection of independent Claim 27, and Claims 28-38 depending therefrom, as obvious in view of *Berman* and *Laronga* and *Messerschmidt***

As discussed above, the combination of *Berman* and *Laronga* is impermissible. Even if combined, *Berman* and *Laronga* do not teach or suggest all the limitations of Claim 27; specifically, a sample interface of a material functionally transparent to infrared light, having a thickness less than 0.1 inch, and adapted to support an ex vivo sample. *Messerschmidt* does not supply the missing teachings, and consequently there is no *prima facie* case of obviousness of Claim 27, and Claims 28-38 depending therefrom.

**Conclusion**

Applicant has responded to each and every rejection and urges that the Claims as presented are in condition for allowance. Applicant requests expeditious processing to issuance.